

REMARKS

Claim 4 is amended to delete a multiple dependency and to delete dependencies based on canceled claims. Claims 18 and 19 are amended to place these claims in independent form. Claims 1, 2, 5-9, 13, 14, 17, 20 and 21 are canceled.

Claims 1-8, 12, 14-20, and 22-24 are rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 6,041,315 to Danford-Klein et al. (“DK”) in view of printouts from U-Haul’s web site allegedly dated January 25, 1998 (“U-Haul”). Claims 9-11, 21 and 25 are rejected under 35 U.S.C. §103 as being unpatentable over DK in view of U-Haul and further in view of U.S. Patent 6,125,384 to Brandt et al. (“Brandt”). Reconsideration of the application in light of the remarks below is respectfully requested. It is asserted that the present communication places the application in a form for allowance or in a better condition for appeal. Entry is respectfully requested.

To facilitate prosecution on the merits, claims 1, 2, 5-9, 14, 17, 20 and 21 are canceled.

In order to establish a *prima facie* case of obviousness: 1) the Office Action must show a suggestion or motivation in the references or in the knowledge of one with ordinary skill in the art, to modify or combine the references and 2) the prior art references must teach or suggest all of the claim limitations. M.P.E.P. §706.02(j). Both elements are missing here.

Claims 3, 4, 10, 11, 15, 19, and 22-25

Among the limitations of independent claim 3, which are neither shown nor suggested in the art of record are:

programming...which accesses the memory and provides to the user computer over the communications network data indicating at least two locations closest to the geographic location input for pick-up and at least two locations nearest to the geographic location input for drop-off.

Among the limitations of independent claim 10, which are neither shown nor suggested in the art of record are:

at least one program module for processing the user inputs and the truck-related information to determine and display to the user a set of closest locations associated with a departure location and a destination location specified by the user, to access and display directions from a user-specified address to the departure and destination locations....

Among the limitations of independent claim 15, which are neither shown nor suggested in the art of record are:

providing the user with information identifying at least two locations closest to the vehicle pick-up location and at least two locations nearest to the vehicle drop-off input by the user.

Among the limitations of now independent claim 19, which are neither shown nor suggested in the art of record are:

accessing the affiliate table to determine the closest affiliates to the departure and destination locations, respectively;

accessing travel directions for the closest affiliates;
and
providing the travel directions for display to the
user.

The Office Action agrees that the above limitations are not shown in DK and points to U-Haul page 9. See, e.g., Office Action, page 5. Page 9 of U-Haul includes the text “Find the U-Haul Locations Closest to You” and then includes fields for entering an address. There is no indication in the pages of U-Haul cited by the Examiner that any results were ever produced from this query entry. Even if results were produced, the query asked for only a user’s address which may not even relate to a pickup or departure location and clearly does not relate to a drop off or destination. Further, in U-Haul, there is no disclosed query or disclosed results for displaying multiple locations for a both pick-up and drop off or for departure and destination – as is claimed in independent claims 3, 10, 15 and 19.

Moreover, the Office Action states that it would have been obvious to combine a “memory in which is stored a data set relating to pick-up and drop-off locations for vehicles to be rented” from DK (OA, page 5) with the above discussed portions of U-Haul, “with the motivation of helping customers plan their own do-it yourself move. . . .” Id. However, the customer knows where his origination and destination points are and showing the customer multiple locations for both pick-up and drop off or for departure and destination will not help that customer plan his own move. Therefore, the motivation set forth in the Office Action is not maintainable.

Claims 10 and 19 includes further recitations relating to the storage of travel directions. The Office Action admits that such recitations are not shown even in the combination of U-Haul and DK and simply states that such knowledge is well known in the computer arts. Office Action, page 10. Applicants request that the Examiner set forth a reference which shows such a

teaching or that the Examiner submit an Examiner's affidavit indicating that such knowledge is known by one of ordinary skill in the art at the time of the invention so that Applicants have the opportunity to rebut such an assertion. See M.P.E.P. § 2144.03. Absent such information, a *prima facie* case of obviousness cannot be made.

Moreover, the asserted motivation for combining this knowledge of travel directions with DK and U-Haul is not defendable. The Office Action states that the motivation for making this combination is for "enabling the user to travel to the nearest affiliate." Office Action, page 10. Clearly, the user may be able to travel to the nearest affiliate without directions, could find directions on his own, and may even know where the affiliate is when informed of the address. Traveling to an affiliate does not necessarily require knowledge of travel directions.

Therefore it is asserted that independent claims 3, 10, 15 and 19 are patentable over the art of record. Claims 4, 11 and 22-25 all include the above limitations of claims 3, 10, 15 and 19 respectively and further recite limitations which, together with the limitations of claims 3, 10 and 19, are also neither disclosed nor suggested in the art of record. It is asserted that these claims are patentable as well.

Claims 12 and 16

Among the limitations of independent claim 12, which are neither shown nor suggested in the art of record are:

a web page including data fields containing all information necessary for a service contract, the information either provided in response to user input or available from the system, in which all data fields may be modified on the web page by the user without having to revert to another web page.

Similarly, among the limitations of independent claim 16, which are neither shown nor suggested in the art of record are:

a reservation form on a web page which contains all reservation information provided in response to user input which may be changed by the user directly on the form on that web page without having to access another web page.

The Office Action admits that the above limitations are not shown in DK and points to U-Haul, pages 5-7. Office Action, page 7. These pages of U-Haul show the ability to request a rate for a particular move and not information “necessary for a service contact” as in claim 12 or “reservation information” as in claim 16. For example, page 5 of U-Haul suggests a phone number to call a “reservation representative”, and includes a query for an “approx. date needed” and not a definite date. Page 6 of U-Haul recites a recommendation for holding a rate quote as a “Non-Paid Tentative Reservation”. This is further support that the U-Haul pages shown relate only to a rate quote, not a service contract or a reservation, and further that the rate quote could be turned into a tentative reservation – still not a complete reservation or information necessary for a service contact. The Office Action agrees with this assessment by stating “U-Haul discloses a website with a rate request form where user {sic.} can enter all data from one web page. . . .” Office Action, page 7.

Moreover, the asserted motivation for combining the above referenced portions of U-Haul with DK is not tenable. The Office Action states that the motivation for making this combination is for “”helping customers plan their own do-it yourself move. . . .” Office Action, page 8. Clearly, including all the information necessary for a “service contact” as in claim 12 or “reservation information” as in claim 16 would not do anything in assisting a customer in planning their own move.

Therefore, it is asserted that independent claims 12 and 16 are patentable over the art of record.

Claim 18

Among the limitations of now independent claim 18, which are neither shown nor suggested in the art of record are:

receiving user-input selections of equipment including a selection of a truck for rental and a selection of a vehicle type for towing by the selected truck;
accessing the vehicle towing table to determine if the selected vehicle is capable of being towed by the selected truck; and
generating a towing advice indication for display to the user whether the selected truck is appropriate for towing the selected vehicle.

The Office Action agrees that the above limitations are not shown even in a combination of DK and U-Haul. Office Action, page 9. The Office Action then perfunctorily states it would have been obvious to add these teachings to the combination of DK and U-Haul and indicates that the motivation for making this combination is “preventing the user from selecting a truck incapable of towing desired vehicle.” Office Action, page 9.

The prior art must both show all of the claimed limitations and a motivation for combining the cited art. M.P.E.P. §706.02(j). In this case, there is no prior art reference cited for either the above recitations or a motivation to combine those teachings with the combination of DK and U-Haul. Absent either one of such showings, a *prima facie* case of obviousness cannot be made.

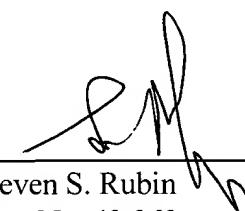
Applicants request that the Examiner set forth a reference which shows the above alleged teachings or that the Examiner submit an Examiner's affidavit indicating that such knowledge is known by one of ordinary skill in the art so that Applicants have the opportunity to rebut such an assertion. See M.P.E.P. § 2144.03. Moreover, Applicants request that the Examiner set forth a reference which shows the above asserted motivation for combining the cited references or that the Examiner submit an Examiner's affidavit indicating that such motivation is known by one of ordinary skill in the art so that Applicants have the opportunity to rebut such an assertion as well. See M.P.E.P. § 2144.03.

Without such information from the Examiner, a prima facie case of obviousness cannot be made and, as such, it is asserted that claim 18 is patentable over the art of record.

Reconsideration of the rejection of claims 3, 4, 10-12, 15, 16, 18, 19, 22-25 under 35 U.S.C. §103 is respectfully requested in light of the remarks above.

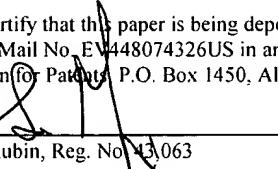
Respectfully submitted,

Date: 10/19/04

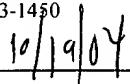


Steven S. Rubin
Reg. No. 43,063
BROWN RAYSMAN MILLSTEIN
FELDER & STEINER LLP
900 Third Avenue
New York, New York 10022
Tele: (212) 895-2906
Fax : (212) 895-2900

I hereby certify that this paper is being deposited this date with the U.S. Postal, as Express Mail No. EW448074326US in an envelope addressed to: Mail Stop AF, Commission for Patents, P.O. Box 1450, Alexandria VA 22313-1450



Steven S. Rubin, Reg. No. 43,063



Date 10/19/04